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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,982	07/10/2000	David Moshe Goldschlag	1999-32	9438
23823	7590	10/06/2004	EXAMINER	
Digital Video Express, LP 1408 BAYSHIRE LANE Herndon, VA 20170			TRAN, TONGOC	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/612,982

Applicant(s)

GOLDSCHLAG ET AL.

Examiner

Tongoc Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to applicant's amendment filed on 6/18/2004.

Claim 17 has been amended. Claims 1-19 are pending.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 recites the limitation "said multitude of manufacturers" on page 3.

There is insufficient antecedent basis for this limitation in the claim.

### ***Response to Arguments***

3. Applicant's arguments, see page 8, filed 6/18/2004, with respect to claim 1 has been fully considered and are persuasive. The rejection of claim 1 has been withdrawn.

The rejection of dependent claims 2-12 have been withdrawn because by their dependency, they contain the language of claim 1.

Applicant's arguments with respect to claims 13-19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (U.S. Patent No. 6,233,685, hereinafter Smith) in view of Sims, III (U.S. Patent No. 6,438,235 hereinafter Sims).

In respect to claim 13, Smith discloses an apparatus for manufacturing trusted devices comprising:

A multitude of trusted devices, each of said trusted devices generating a final private trusted device key and final public trusted device key wherein said manufacture certifies said public trusted devices key (see Smith, col. 5, lines 1-55).

Smith discloses generating a private and public key in the multitude of devices but does not explicitly disclose the key are generated with the keying material provided from the licensing authority and receiving the key from the manufactures but Sim discloses:

(a) a licensing authority for providing keying information; (b) multitude of manufactures receiving keying information from the licensing authorities and (c) a multitude of trusted devices receiving the keying material from the manufacture (see Sims, col. 1, lines 22-45 and col. 2, 46-62). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Sims' dissemination of secret information only by license with the teaching of Smith for generating public and private key from the device and certified by device manufactures in order to globally keeping secret how the cryptographic keys are made (Sims, col. 1, lines 35-37).

In respect to claim 14, Smith and Sims disclose an apparatus according to claim 13, wherein said licensing authority includes a database, said database containing trusted device records (see Sims, col. 14, lines 35-39).

In respect to claim 15, Smith and Sims disclose an apparatus according to claim 14, wherein said trusted device records include a public key (see Sims, col. 14, lines 35-39).

In respect to claim 16, Smith and Sims disclose an apparatus according to claim 14, wherein said trusted device records include:

(a) a trusted device identifier (b) a manufacturer identifier (see Sims, col. 14, lines 35-40).

In respect to claim 17, Smith and Sims disclose an apparatus according to claim 14, wherein said trusted device records include a set top box public key (see Sims, col. 10, lines 40-55).

In respect to claim 18, Smith and Sim disclose an apparatus according to claim 14, wherein said trusted device records include a manufacturer's certificate (see Smith, col. 5, lines 1-25).

In respect to claim 19, Smith and Sims disclose an apparatus according to claim 14, wherein said trusted device records include a communications identifier for identifying a device with which the trusted device may communicate (see Sims, col. 21, lines 10-30).

***Allowable Subject Matter***

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5. Claims 1-12 are allowed.

The following is an examiner's statement of reasons for allowance:

The present invention is directed to manufacturing a trusted device by reducing the trust that the licenser of such devices needs to place in the manufacturer of these devices. Claim 1 identifies the unique features the trusted device generating a temporary private key; computing a final private key using said temporary private key and a keying information received from the manufacturer, said manufacturer received said keying information from the licensing authority; computing a final public key using said temporary private key and said keying information. The cited prior art, Sims III (U.S. Patent No. 6,438,235), Eldridge et al. (U.S. Patent No. 6,094,721) and de Silva et al. (U.S. Patent No. 6,615,347) either singularly or in combination fail to anticipate or render the above underlined limitation obvious.

#### Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690 or (571) 272-3842 after 10/21/2004. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789 or (571) 272-3838 after 10/21/2004. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7240.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-9600.

Examiner Tongoc Tran  
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TT

  
September 24, 2004

  
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